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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Jia-Jiun Yeh et al.
Appl. No.	:	10/815,884
Filed	:	March 31, 2004
For	:	COLOR-CHANGEABLE PIXELS OF AN OPTICAL INTERFERENCE DISPLAY PANEL
Examiner	:	Jessica T. Stultz
Group Art Unit	:	2873

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request a pre-appeal brief review of the legal and factual basis of the rejections in the August 31, 2006 Final Office Action and the November 14, 2006 Advisory Action. No amendments are being filed with this request, and this request is being filed with a notice of appeal.

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REMARKS

In the August 31, 2006 Final Office Action, the Examiner rejects Claims 1-10 and 17-20 under 35 U.S.C. § 112 as lacking adequate written description. The Examiner also rejects Claims 1-6, 8-10, and 17-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0027636 by Yamada (hereinafter "Yamada '636") and rejects Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Yamada '636 in view of U.S. Patent No. 6,809,788 issued to Yamada (hereinafter "Yamada '788"). In the November 14, 2006 Advisory Action, the Examiner reaffirms these rejections.

Response to Rejection of Claims 1-10 and 17-20 under 35 U.S.C. § 112

Claims 1-10 and 17-20 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate written description. In the Final Office Action, the Examiner asserts that Claims 1, 17, and 19 contain subject matter concerning the application of a voltage difference to the electrodes of a color-changeable pixel which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

The Final Office Action states that the phrase "in response to a voltage difference applied to the first electrode and the second electrode" of Claim 1 as currently pending is not supported by the specification or the drawings. Applicants respectfully disagree and submit that the phrase is supported by the specification as filed, including but not limited to: page 1, lines 23-24; page 2, lines 12-16; page 3, lines 3-8; and page 6, line 25 – page 7, line 10.

As a preliminary matter, in the Advisory Action, the Examiner implies that the above-cited portions of the specification may somehow be inapplicable as written description for the claimed invention to the extent that they describe aspects of other patents or previously known devices. However, "[i]t is now well accepted that a satisfactory description may be in the claims or **any other portion** of the originally filed specification." M.P.E.P. § 2163(I) (emphasis added). Thus, portions of the specification which give background information by describing aspects of other similar devices can serve as written description for the claimed invention.

Written description support for a claimed invention may be found in express, implicit, or inherent disclosure. M.P.E.P. § 2163(I)(B). Moreover, that which is well known to one of ordinary skill in the art need not be disclosed in detail. *See Hybritech Inc. v. Monoclonal*

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Antibodies, Inc., 802 F.2d 1367, 1384 (Fed. Cir. 1987); *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005) ("The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge."). Thus, if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1555, 1563 (Fed. Cir. 1991); *Martin v. Johnson*, 454 F.2d 746, 751 (C.C.P.A. 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

Applicants submit that the specification as filed provides adequate written description support for the phrase "in response to a voltage difference applied to the first electrode and the second electrode," as recited by Claim 1. For example, at page 2, lines 12-16, the specification states: "Fig. 2 illustrates a cross-sectional view of the modulator 100 in Fig. 1 after a voltage is applied to it. Under the applied voltage, the wall 104 is flexed by electrostatic attraction toward the wall 102." Walls 102 and 104, as well as the corresponding reference numbers in other figures, are repeatedly referred to throughout the specification as electrodes (*see, e.g.,* page 7, lines 18-19).

In the Advisory Action, the Examiner points out that the cited portions of the specification do not explicitly disclose a "voltage difference applied to the first electrode and the second electrode." However, Applicants submit that it would have been clear to one having skill in the pertinent art that the specification as filed describes the application of voltage differences to the first electrode and the second electrode, and that Applicants were in possession of the subject matter recited in Claim 1 as currently pending.

First, to the extent that the specification describes the application of a voltage to an electrode (*see, e.g.,* page 1, lines 23-24), persons skilled in the art would recognize such a description as describing the application of an electric potential difference between the electrode and some other reference point. This is true because the concept of "voltage" is scientifically defined in terms of an electric potential difference between two points. When the specification describes applying a voltage to an electrode, persons skilled in the art understand that the specification is disclosing the application of an electric potential difference to the electrode with reference to some other point. Other portions of the specification refer to the application of a

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voltage to the modulator 100 and that under the applied voltage, one of the electrodes (the wall 104) is flexed toward the other (the wall 102) by electrostatic attraction (*see, e.g.*, page 2, lines 12-14; page 3, lines 3-4). One having skill in the pertinent art would recognize that “a voltage difference applied to the first electrode and the second electrode” is inherent in this disclosure, for without such a voltage difference between the electrodes, there would be no electrostatic attraction between the two electrodes.

For at least the reasons set forth above, Applicants submit that one of skill in the art would clearly understand the originally filed specification as showing Applicants to be in possession of the claimed invention recited by Claim 1 and by Claims 2-10 which depend from Claim 1. Therefore, Applicants respectfully request that the rejection of Claims 1-10 be withdrawn and that these claims be passed to allowance.

Claim 17 recites that “the second electrode is movable relative to the first electrode in response to voltage differences applied to the first electrode and the second electrode,” and Claim 19 depends from Claim 17 and recites “the voltage differences.” For reasons similar to those discussed above with regard to Claim 1, Applicants submit that the specification provides adequate written description support for Claims 17 and 19, and for Claims 18 and 20 which depend from Claim 17. Therefore, Applicants respectfully request that the rejection of Claims 17-20 be withdrawn and these claims be passed to allowance.

Response to Rejection of Claims 1-6, 8-10, and 17-20 under 35 U.S.C. § 102(b)

Claims 1-6, 8-10, and 17-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yamada ‘636. Applicants submit that Yamada ‘636 does not anticipate Claims 1-6, 8-10, and 17-20 because Yamada ‘636 fails to disclose every limitation of these claims. Applicants submit that these claims are patentably distinguished over Yamada ‘636 for at least the reasons set forth in the “Amendment and Response to August 31, 2006 Office Action,” under the heading “Response to Rejection of Claims 1-6, 8-10, and 17-20 under 35 U.S.C. § 102(b).” In addition to these arguments of record, Applicants also wish to make the following supplemental arguments.

The Final Office Action and the Advisory Action cite paragraphs 5, 97, 136-149, and 302-307 of Yamada ‘636 as disclosing that “the second electrode is movable relative to the first electrode in response to a voltage difference.” However, paragraphs 5 and 97 make clear that the voltage applied across the electrodes changes the orientation or arrangement state of molecules of

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the liquid crystal between the electrodes. Thus, the voltage applied between the electrodes does not cause either electrode to move at all, let alone with respect to the other.

In the Advisory Action, the Examiner further cites Figs. 2A, 2B, and 3 as disclosing that the second electrode is movable relative to the first electrode. However, neither of the electrodes E1 and E2 illustrated in Fig. 3 of Yamada '636 is shown as being movable **relative to the other**. Fig. 2B of Yamada '636 shows that the entire LCD display is deformed but, even after the display is deformed, each electrode E1 and E2 remains in the same position **relative to the other**, just as the substrates upon which they are formed remain in the same position relative to one another.

For at least these reasons, Applicants submit that Claims 1 and 17 (and dependent Claims 2-6, 8-10, and 18-20) are patentably distinguished over Yamada '636. Applicants respectfully request that the rejection of Claims 1-6, 8-10, and 17-20 be withdrawn and these claims be passed to allowance.

Response to Rejection of Claim 7 under 35 U.S.C. § 103(a)

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada '636 in view of Yamada '788. However, Applicants submit that Claim 7 is patentably distinguished over the cited combination for the reasons set forth in the "Amendment and Response to August 31, 2006 Office Action," under the heading "Response to Rejection of Claim 7 under 35 U.S.C. § 103(a)." Applicants respectfully request that the rejection of Claim 7 be withdrawn and this claim be passed to allowance.

CONCLUSION

For the foregoing reasons, Applicants submit that Claims 1-10 and 17-20 are in condition for allowance, and Applicants respectfully request such action.

Respectfully submitted,

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Dated: 1/2/07

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